



09-06-07

HW

3694

PTO/SB/21 (04-07)

Approved for use through 09/30/2007. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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**TRANSMITTAL  
FORM**

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

21

Application Number

10/031,138-Conf. #8211

Filing Date

May 2, 2002

First Named Inventor

Hiroshi Miyawaki

Art Unit

3694

Examiner Name

A. Basit

Attorney Docket Number

967\_022

**ENCLOSURES (Check all that apply)**☐ Fee Transmittal Form☐ Fee Attached☒ Amendment/Reply☐ After Final☐ Affidavits/declaration(s)☐ Extension of Time Request☐ Express Abandonment Request☒ Information Disclosure Statement☐ Certified Copy of Priority Document(s)☐ Reply to Missing Parts/  
Incomplete Application☐ Reply to Missing Parts under  
37 CFR 1.52 or 1.53☐ Drawing(s)☐ Licensing-related Papers☐ Petition☐ Petition to Convert to a  
Provisional Application☐ Power of Attorney, Revocation  
Change of Correspondence Address☐ Terminal Disclaimer☐ Request for Refund☐ CD, Number of CD(s) \_\_\_\_\_☐ Landscape Table on CD☐ After Allowance Communication  
to TC☐ Appeal Communication to Board of  
Appeals and Interferences☐ Appeal Communication to TC  
(Appeal Notice, Brief, Reply Brief)☐ Proprietary Information☐ Status Letter☒ Other Enclosure(s) (please  
Identify below):Communication to Record  
Substance of Interview (4 pages),  
PTO/SB/08A (1 page), Return  
Receipt Postcard, Certificate of  
Express Mailing

Remarks

**SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT**

Firm Name

MARJAMA MULDOON BLASIAK &amp; SULLIVAN LLP

Signature

Printed name

Dmitry Andreev

Date

September 5, 2007

Reg. No.

57,428

**Transmittal**

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the U.S. Postal Service as Express Mail, No. EM154106798US, on the date shown below in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: September 5, 2007

Signature:

(Susan Pagano)



PTO/SB/17 (07-07)  
Approved for use through 06/30/2010. OMB 0651-0032  
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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<b>Effective on 12/08/2004.</b> <b>Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).</b>		<b>Complete if Known</b>	
<b>FEE TRANSMITTAL</b> <b>For FY 2007</b>		Application Number	10/031,138-Conf. #8211
		Filing Date	May 2, 2002
		First Named Inventor	Hiroshi Miyawaki
		Examiner Name	A. Basit
		Art Unit	3694
<input type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27		Attorney Docket No.	967_022
TOTAL AMOUNT OF PAYMENT		(\$)	180.00

**METHOD OF PAYMENT (check all that apply)**

☐ Check   ☐ Credit Card   ☐ Money Order   ☐ None   ☐ Other (please identify): \_\_\_\_\_

☒ Deposit Account   Deposit Account Number: 50-0289   Deposit Account Name: Marjama Muldoon Blasiak & Sullivan LLP

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☒ Charge fee(s) indicated below   ☐ Charge fee(s) indicated below, except for the filing fee

☒ Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17   ☒ Credit any overpayments

**FEE CALCULATION****1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

**2. EXCESS CLAIM FEES**

Fee Description	Fee (\$)	Small Entity Fee (\$)
Each claim over 20 (including Reissues)	50	25
Each independent claim over 3 (including Reissues)	200	100
Multiple dependent claims	360	180

<u>Total Claims</u>	<u>Extra Claims</u>	<u>Fee (\$)</u>	<u>Fee Paid (\$)</u>	<u>Multiple Dependent Claims</u>
				<u>Fee (\$)</u> <u>Fee Paid (\$)</u>

HP = highest number of total claims paid for, if greater than 20.

<u>Indep. Claims</u>	<u>Extra Claims</u>	<u>Fee (\$)</u>	<u>Fee Paid (\$)</u>

HP = highest number of independent claims paid for, if greater than 3.

**3. APPLICATION SIZE FEE**

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

<u>Total Sheets</u>	<u>Extra Sheets</u>	<u>Number of each additional 50 or fraction thereof</u>	<u>Fee (\$)</u>	<u>Fee Paid (\$)</u>

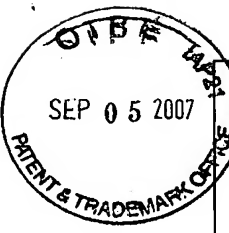
**4. OTHER FEE(S)**

Non-English Specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): 1806 Submission of an Information Disclosure Statement   180.00

<b>SUBMITTED BY</b>		Registration No.	57,428	Telephone	(315) 425-9000
Signature		(Attorney/Agent)		Date	September 5, 2007
Name (Print/Type)	Dmitry Andreev				

<b>Fee Transmittal</b>	
I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the U.S. Postal Service as Express Mail, No. EM154106798US, on the date shown below in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.	
Dated: September 5, 2007	Signature: _____ (Susan Pagano)



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Dated: September 5, 2007    Signature: \_\_\_\_\_  
(Susan Pagano)

Docket No.: 967\_022  
(PATENT)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:  
Hiroshi Miyawaki

Application No.: 10/031,138

Confirmation No.: 8211

Filed: May 2, 2002

Art Unit: 3694

For: INTERNET CHARGING SYSTEM

Examiner: A. Basit

**COMMUNICATION TO RECORD SUBSTANCE OF INTERVIEW**

MS Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

A telephone interview was held on August 29, 2007 between Examiner Abdul Basit and applicant's representatives George S. Blasiak and Dmitry Andreev.

Mr. Blasiak began the interview by reading the following statement: "The interview will be focused on a limited number of issues for purposes of reducing the time of the interview, and for purposes of expediting an allowance. The focused nature of the interview will not be taken as an indication that arguments for unpatentability by the Examiner not discussed are conceded to be correct and appropriately made. applicants expressly reserve the right, later in prosecution of the present application or another application, to challenge the propriety of the outstanding office action on grounds not discussed in the interview."

Mr. Blasiak stated that the interview will be focused on Claims 1-3 only. Mr. Blasiak further stated that in the Office action Claim 1 has been rejected under §102(e) over Wright, and Claims 2 and 3 have been rejected under §103(a) over Wright in view of Han. Mr. Blasiak read the anticipation requirements of MPEP §2131 requiring the

reference to teach every element of the claim. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Mr. Blasiak further stated that in accordance with a recent Supreme Court opinion in *KSR International CO. v. Teleflex Inc.* 127 S.Ct. 1727, to determine obviousness under 35 USC §103(a), "the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved, and hence one or more references must teach and every element of the claim."

Mr. Blasiak further stated that the filing date of the Wright reference itself did not qualify as a prior art against the applicant under §102(e), since the applicant claimed a priority date of May 16, 2000 based upon a foreign filing. Mr. Blasiak further stated that the applicant noted that while Wright claimed a priority date based upon a provisional application, the provisional application did not contain the paragraphs relied upon by the Office action of June 5, 2007. Mr. Blasiak further stated that for the purposes of this interview, the applicant's attorneys would proceed as if Wright did qualify as a prior art against the applicant.

Mr. Andreev asked the Examiner to identify where in the relied upon reference there is a teaching of the last limitation of Claim 1, which teaches a "customer select[ing] desired information from the information in the transmitted charging table." The Examiner stated that Wright (Paragraph 9) discloses a consumer utilizing an Internet service. Mr. Andreev explained that the claim limitation in question contains at least two elements; the charging table, and the customer selecting information from the charging table, none of which are suggested by Wright. The Examiner stated he was not able to pinpoint other passages in Wright which would anticipate the claim limitation and that if the elements in question were not found in Wright, that would certainly help establishing the claim novelty although for a business method claim, a second search would be needed.

Mr. Andreev asked the Examiner to identify where in the relied upon reference there is a teaching of a limitation of Claim 2, which teaches "an advertisement data

controller for controlling a size and display time which is sent to the terminal server.” The Examiner stated that Han (Paragraphs 8-12) taught custom-made advertisements, which in Examiner’s opinion suggested controlling the size and display time of the advertisements. Mr. Andreev stated that custom-made advertisements might at best suggest custom-tailored content rather than size, and that in his opinion the passage quoted by the Examiner did not anticipate the size and display time of the advertisements. The Examiner stated that he could not pinpoint any other passages in Han.

Mr. Andreev asked the Examiner to identify where in the relied upon reference there is a teaching of a limitation of Claim 2, which teaches “an Internet access service providing method, an advertisements distribution method, and the charging method associated with Internet access [being] changed according to the state of Internet usage by the consumer and the result of the selection by the customer of the desired information in the charging table.” Mr. Andreev asked the Examiner to specifically pinpoint where in the relied upon reference there are teachings related to the three methods being changed according to the state of the Internet usage, and the selection by the customer of the information in the charging table. The Examiner stated that the abstract of Han, although not cited in the Office action, discloses “enabling the user to utilize a web browser having the motion picture advertising window in the icon tool collection box, multi-casting custom made advertisements suitable for the tendency of users by accessing in real time to said motion picture advertising window so that it efficiently maximizes the effect of advertisement.” Mr. Andreev stated that the quoted passage did not anticipate the claim limitations being discussed. The Examiner replied that he was not able to pinpoint any additional passages.

Mr. Andreev asked the Examiner to identify where in the relied upon reference there is a teaching of a limitation of Claim 3, which teaches “in the information terminal, ... an access setting database having an access table which includes information on plural providers such as phone numbers, ID numbers, passwords, thereby automatically changing a provider.” The Examiner referred to Wright (Paragraphs 29-30). Mr. Andreev stated that Wright discloses a rating device and associated methods and

devices residing on the Internet Service Provider (ISP) side, while Claim 3 taught an access database residing on the information terminal and containing information on the plural providers. The Examiner stated that if the applicant's attorney's interpretation was correct, that Wright did not anticipate the discussed claim limitation.

Mr. Blasiak suggested that the applicant's attorneys would prepare a formal response to the Office action, and the interview summary. The Examiner agreed.

If the Examiner believes that contact with applicant's attorney would be advantageous toward the disposition of this case, the Examiner is herein requested to call applicant's representative at the phone number listed below.

The Commissioner is hereby authorized to charge any additional fees associated with this communication or credit any overpayment to deposit Account No. 50-0289.

Dated: September 5, 2007

Respectfully submitted,

By

  
Dmitry Andreev

Registration No.: 57,428

**MARJAMA MULDOON BLASIAK & SULLIVAN LLP**

250 South Clinton Street

Suite 300

Syracuse, New York 13202

(315) 425-9000

Customer No. 20874

DA/slp